

### **REMARKS**

Claims 1-48 were pending. Claims 7, 10, 12, 16, 18, 23-25, and 40 were amended. Claim 49 is new. Therefore, claims 1-49 are currently pending.

No new matter has been added. Claims 7, 12, 16, 23-25 and 40 were amended to clarify the invention. Support for new claim 49 can be found at least in claim 24 as originally filed and on page 2, line 17 of the specification as originally filed.

#### ***Non-Statutory Rejection of Claims 1-48 under Judicially Created Doctrine of Double Patenting***

Claims 1-48 are provisionally rejected under the judicially created doctrine of double patenting over claims 1, 4-6 and 8 of U.S. Patent No. 6,617,318. The Office Action indicates that a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.312(c) may be used to overcome a rejection based on a non-statutory double patenting ground provided the conflicting application is shown to be commonly owned with this application. It is respectfully submitted that a terminal disclaimer will be filed upon an indication of allowable subject matter, if appropriate.

#### ***Rejection of Claims 7, 9, 10, 12, 13, 16, 18, 23-25 and 40 Under 35 U.S.C. §112, first paragraph***

Claims 7, 9, 10, 12, 13, 16, 18, 23-25 and 40 were rejected under 35 U.S.C. § 112, second paragraph, as being “indefinite for failing to particularly point out and distinctly claim the invention.”

Claims 7, 9, 10, 12, 13, 16, 18, 23-25 and 40 have been amended such that this rejection no longer pertains to the claims as currently amended. Therefore, Applicants respectfully request that this rejection of claims 7, 9, 10, 12, 13, 16, 18, 23-25 and 40 under 35 U.S.C. § 112, second paragraph, be withdrawn.

#### ***Rejection of Claims 1, 2, 10, 18-23, 25, 26, 47 and 48 under 35 U.S.C. § 102(a)***

Claims 1, 2, 10, 18-23, 25, 26, 47 and 48 are rejected under 35 U.S.C. § 102(a) as being anticipated by Koza, *Org. Lett.* (2000), 2:6, 815-817 (“Koza”). According to the Examiner, Koza discusses “7-substituted tetracycline derivatives such as...7-(4-nitrophenyl)sancycline and 7-(4-dimethylphenyl) sancycline.”

The Koza reference represents Applicants’ own work, published within one year of the filing of the priority application, and cannot be used against Applicants under 35 U.S.C. § 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1958).

Therefore, Applicants respectfully request that this rejection of claims 1, 2, 10, 18-23, 25, 26, 47 and 48 under 35 U.S.C. § 102(a) be withdrawn.

***Rejection of Claims 1-48 under 35 U.S.C. § 103(a)***

Claims 1-48 are rejected under 35 U.S.C. § 103(a) as being anticipated by Koza. According to the Examiner, "the instant claims differ from the reference by reciting compounds not exemplified by the reference."

The Koza reference represents Applicants' own work, published within one year of the filing of the priority application, and cannot be used against Applicants under 35 U.S.C. § 103(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1958).

Therefore, Applicants respectfully request that this rejection of claims 1-48 under 35 U.S.C. § 103(a) be withdrawn.

**SUMMARY**

Cancellation of and/or amendments to the claims should in no way be construed as an acquiescence to any of the Examiner's objections and/or rejections. The cancellation of and/or amendments to the claims are being made solely to expedite prosecution of the above-identified application. Applicants reserve the option to further prosecute the same or similar claims in the present or another patent application. The amendments made to the claims are not related to any issues of patentability.

In view of the above remarks and amendments, it is believed that this application is in condition for allowance. If a telephone conversation with Applicant's Attorney would expedite prosecution of the above-identified application, the Examiner is urged to call Elizabeth A. Hanley, Esq. at (617) 227-7400.

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